

REMARKS

The application has been amended and is believed to be in condition for allowance at the time of the next Official Action.

There are no formal matters outstanding.

Claims 1-15 were previously pending. Claims 16-19 are new and depend from independent claim 9. Claim 20 is new and depends from claim 1.

Claim 9 has been amended to clarify that the payment operator system is remote from the payment terminal. The invention communicates locally between the mobile communication unit and the payment terminal, and communicates remotely via the mobile communication unit to the payment operator system.

Claims 1-8 stand rejected under §103 as obvious over HEINONEN et al. 6,078,806 (HEINONEN) in view of ELBAUM 6,010,067.

Claims 9-10, 12-13, and 15 stand rejected as anticipated by HEINONEN.

Claims 11 and 14 (depending from claim 9) stand rejected as obvious over HEINONEN in view of ELBAUM.

Consider the anticipation rejection first. Applicant does not believe that the reference teaches each recited feature of the invention.

HEINONEN basically teaches that a mobile phone may include modules for executing specific programmed functions, such as acting as a cash card or as digital cash so as to allow local

communication between the mobile phone and some local device, e.g., a cash register.

See the Abstract disclosing a method for using an application (18) in a mobile station (1), the application (18) controls a master control unit (MCU) of the mobile station (1). Also provided is a system for making payments between the mobile station (1) which has an associated payment application (18) for providing local data transfer to a cash register (21). The application (18) has a capability for causing data to be transferred from the mobile station to the cash register.

This of course is not the recited method of claim 9, or of the newly-added dependent claims 16-19.

HEINONEN (column 5, line 45 and column 8, lines 15-25) would use a mobile phone to establish a communication connection with a payment terminal. Note though that this connection appears to be for the transfer of funds from the mobile phone to the payment terminal.

See column 3, beginning at line 27 (emphasis added):

"Remarkable advantages are ... the mobile stations related to the invention can also be used e.g. **as a credit card and/or as a cash card, instead of traditional plastic cards.**"

See next the claim 9 recitation of "in establishing the communication connection between the mobile communication device and the payment terminal, **making an initial data transfer from the**

mobile communication unit comprising information concerning identification of the customer and the sales location."

For this recitation, column 5, line 45 was offered. Applicant does not find such disclosure in the column 5, line 45 passage: "The mobile station 1 also comprises a first means of data transfer, such as an infra red IR transmitter/receiver. The first means of IR data transfer can be used to transfer data, with relatively short distances, between the mobile station 1 and a cash register (payment terminal) 21 or, e.g., between two different mobile stations 1 (FIG. 7)."

There is only disclosure of data transfer, and no disclosure of the content of that data. There is no disclosure of an initial data transfer from the mobile phone to the cash register of the customer's identification or of the sales location. Thus, the anticipation rejection fails.

The next claim 9 recitation is "after the initial data transfer, transferring, from the payment terminal to the mobile communication unit, information concerning a transaction via the established communication connection, the transferred information concerning the transaction including a transaction amount."

For this feature, the Official Action has offered column 12, lines 25-55 and column 13, lines 25-55. These passages correspond to patent claims 14 and 12-15, reproduced below in relevant parts:

"1. A system for effecting payments, ...

"at least one payment reception terminal which has a second means for providing local data transfer, said second means for providing local data transfer being coupled to said first means for providing local data transfer through a wireless interface; and"

"wherein the application comprises means for transferring data between the first means for providing local data transfer and the second means for providing local data transfer through said wireless interface, for registering a payment transaction in the payment reception terminal."

The recited first means is the mobile phone and the recited second means would be the cash register. The claim only indicates that the two devices communicate for registering a payment transaction. In view of the teachings concerning the mobile phone acting as, e.g., a cash card, the teaching is only of a debit against the mobile phone. In any event, there is no teaching of the recited "transferring, from the payment terminal to the mobile communication unit, information concerning a transaction via the established communication connection, the transferred information concerning the transaction including a transaction amount." The HEINONEN system allows the phone user to enter an amount on the phone which is authorized to be transferred to the cash register. See method claim 13.

As to the HEINONEN method claim (emphasis added):

"13. A method for operating a payment system ...

"entering information into the first, user terminal specifying that a payment be made from the first, user terminal to the second terminal;

"establishing a communication link from the at least one application to the second terminal through a wireless interface; and

"registering a payment transaction with at least one of the second terminal and the at least one application."

See that claim 13 indicates that the user operates the phone to control the transaction. The claim does not disclose "transferring, from the payment terminal to the mobile communication unit, information concerning a transaction via the established communication connection, the transferred information concerning the transaction including a transaction amount."

The method claims recite the phone being used as a portable ATM. See claim 14 reciting the input of a PIN (personal information number) into the phone in the same manner as would be required at a conventional ATM in order to authorize a transfer of funds from the phone to the cash register.

Original claim 9 also recited "transferring from the mobile communications unit to a payment operator system information comprising the information concerning the transaction, the transfer to the payment operator system being placed through a

network comprising a mobile communication network used by the mobile communication unit."

For this recitation, column 12, lines 25-65, which lines correspond to claims 1-7. Communication with a payment operator system is not seen in any of these claims. However, in the interest of ensuring the claim is properly construed, this recitation has been amended to add the payment operator system being remote from the payment terminal. This ensures that the claim recites the invention communicating locally between the mobile communication unit and the payment terminal, and communicating remotely via the mobile communication unit to the payment operator system.

This feature is also not seen as being anticipated.

Claim 9 concludes with a wherein clause "the information concerning the sales location is initially transferred from the mobile communication unit to the payment terminal, and subsequently the transaction information is transferred from the payment terminal to the mobile communication unit, and thereafter from the mobile communication unit to the [remote] payment operator system via the mobile communication network."

Column 13, line 25 and 55-60 were offered for these recitations.

Line 25 corresponds to claim 12 which recites "A system for effecting payments as set forth in claim 1, wherein the at least one mobile station further comprises a transceiver, said

transceiver being bidirectionally coupled to a communication network." Applicant does see disclosure of a communication network; however, applicant does not see any reference to communications with a remote payment operator system over this communication network.

Lines 55-60 correspond to claim 16, depending from claim 15, in turn from claim 13. These claims are combined below and annotated in bold:

"13. A method for operating a payment system that includes a first, user terminal and a second terminal, the first, user terminal having at least one application, the method comprising the steps of:

entering information into the first, user terminal specifying that a payment be made from the first, user terminal to the second terminal; **[first terminal is phone and second terminal is cash register]**

establishing a communication link from the at least one application to the second terminal through a wireless interface; and registering a payment transaction with at least one of the second terminal and the at least one application,

wherein the at least one application has an associated account balance, and wherein the method further comprises a step of decreasing the associated account balance by an amount of said payment transaction, **[this appears to be using a mobile phone as a stand alone debit card or ATM]**

wherein prior to the performance of the decreasing step, further steps are performed of:

receiving information representing the associated account balance from a network; and

storing the received information representing the associated account balance in the first, user terminal."

The steps of claim 16 fairly indicate that, prior to decreasing the account balance, there is reception of account balance information from the network. Note, however, there is no disclosure if this reception of account balance information is during the transaction or prior to the transaction, i.e., days before when a debit card amount was transferred into the application stored on the mobile phone. Thus, this claim seems to disclose that the mobile phone communicates balance information with a network.

The claim 9 wherein clause "the information concerning the sales location is initially transferred from the mobile communication unit to the payment terminal, and subsequently the transaction information is transferred from the payment terminal to the mobile communication unit, and thereafter from the mobile communication unit to the [remote] payment operator system via the mobile communication network."

Claim 16 of the reference only discloses that before a mobile phone, acting as a money source, must have communicated via a network information concerning an account balance and

stored that balance on the mobile phone, i.e., how much money the mobile phone has to spend, e.g., as digital cash.

It follows that prior to shopping, one goes to an ATM to get cash; has a debit card's value increased; and has the cash value stored on a mobile phone increased. Such is necessary prior to the claim 15 step of: "wherein the at least one application [on the mobile phone] has an associated account balance, and wherein the method further comprises a step of decreasing the associated account balance by an amount of said payment transaction."

In these claims of HEINONEN there appears to be no more disclosed than using a mobile phone as a debit card.

For all the above reasons, the anticipation rejection of claim 9 is not believed to be viable. Reconsideration and allowance of claim 9 and its dependent claims are respectfully requested.

The recitations of new dependent claims 16-19 are also believed patentable over this reference.

HEINONEN is not seen to disclose the further recitations of claim 16:

"the transfer of information concerning the transaction, conducted after the initial data transfer, from the payment terminal to the mobile communication unit, further includes a number and type of goods involved in the transaction;

"the transferring of information from the mobile communications unit to the payment operator system includes the information of the number and type of goods involved in the transaction;

"the information concerning the number and type of goods involved in the transaction is initially transferred from the payment terminal to the mobile communication unit, and subsequently transferred from the mobile communication unit to the payment operator system via the mobile communication network; and comprising the further step of:

"the operator system, after having received the information concerning the number and type of goods, the sales location, and the transaction amount, transmits back to the payment terminal via the mobile communication unit a confirmation that a registration of the transaction has been made at the operator system."

Nor is the claim 17 recitation of providing a notice on the mobile communication unit of the confirmation receipt by the payment terminal, the notice being recognizable by the customer operating the mobile communication unit, found in the reference.

Claims 18-19 contain similar recitations believed to be independently patentable. See "the information detailing the goods or services is initially transferred from the payment terminal to the mobile communication unit, and subsequently

transferred from the mobile communication unit to the payment operator system via the mobile communication network;" and "the operator system, after having received the information detailing the goods or services, the sales location, and the transaction amount, transmits back to the payment terminal via the mobile communication unit a confirmation that a registration of the transaction has been made at the operator system."

Claim 1 was rejected over HEINONEN in view of ELBAUM. As HEINONEN does not teach the features for which it was offered, as discussed above, the rejection as to claim 1 is also not believed to be viable. HEINONEN is offered as disclosing the recited invention less the data identifying the sales location being received in advance by the payment terminal.

For the recitations of:

"- the mobile communication unit transfers data comprising information concerning the transaction via the network to the operator system, and

"- the operator system registers data comprising information concerning the transaction for subsequent charging, invoicing or other settlement,

"wherein the data which are transferred via the communication connection from the payment terminal to the mobile communication unit and the data which are transferred via the network from the mobile communication unit to the operator system

comprise data identifying the sales location and data representing the amount which has to be paid,"

the Official Action has offered HEINONEN's Abstract, Figure 6, and column 12, lines 25-65 and column 13, lines 25-60. These have been discussed above.

Although there is disclosed a network connection to a bank computer 22, the disclosures concerning communications between the mobile unit 1 and the bank computer 22 are not that of the mobile unit transferring data comprising information concerning the transaction to the bank computer.

To the extent that there is disclosure of updating account balances at the bank computer 22, the updating of the account balances advice of the transaction's occurrence and does not include information comprised of the data representing the sales location and data representing the amount which **has to be paid**. The disclosure is updating the bank computer and account balance to reflect amounts paid not an amount which has to be paid.

Therefore, apart from what ELBAUM may teach, and whether such teaching would motivate a change to HEINONEN, the obvious rejection falls short.

To make the temporal relationship clear, claim 20 has been added which recites that "based on the data which are transferred via the communication connection from the payment terminal to the mobile communication unit and then transferred

via the network from the mobile communication unit to the operator system identifying the sales location and data representing the amount which has to be paid, the method comprises the further step of the operator system authorizing payment of the amount to be paid, the authorization being routed via the mobile communication unit to the payment terminal." This is not found in HEINONEN.

As to the ELBAUM providing the acknowledged missing feature of the data identifying the sales location being received in advance by the payment terminal, see that the recitation includes that "the data having been broadcast through a local radio broadcasting system at the sales location." This feature is not found by Applicant in ELBAUM. Therefore, absent this, the recitation remains undisclosed.

Reconsideration and allowance of claim 1, and its dependent claims, are respectfully requested.

As to claim 2, Applicant does not see disclosure of
"-- the operator system transfers data comprising a confirmation that the said registration has been accomplished via the network to the mobile communication unit, whereupon the mobile communication unit may provide an indication that data comprising such a confirmation has been received, and

-- the mobile communication unit transfers data comprising a confirmation that the said registration has been accomplished via the communication connection to the payment

terminal, whereupon the payment terminal may provide an indication that data comprising such a confirmation has been received."

Independent claim 7 is also believed non-obvious for the reasons discussed above.

In summary, applicant respectfully requests reconsideration and allowance of all the pending claims.

Applicant believes that the present application is in condition for allowance and an early indication of the same is respectfully requested.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 CFR §1.16 or under 37 CFR §1.17.

Respectfully submitted,

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